

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUKIO SATO, TSUTOMU OKADA and YAYOI ISHIBASHI

Appeal No. 2000-0182
Application No. 08/831,327

HEARD: March 7, 2001

Before STAAB, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22. Claims 2, 3/2, 4/2, 5 to 9, 10/2, 11/2, 13 and 15 to 21 have been indicated as being drawn to allowable subject matter. Claim 14 has been canceled.¹

We REVERSE and enter new rejections pursuant to 37 CFR § 1.196(b).

¹ Claims 1, 15 and 18 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a grasping forceps for an endoscope. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art of record relied upon by the examiner in rejecting the appealed claims is:

Petruzzi	4,655,219	April 7, 1987
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In addition, the examiner also relied upon the appellants' admission of prior art (specification, pages 1 to 6; Figures 1A, 1B and 2) relating to a grasping forceps for an endoscope (Admitted Prior Art).

Claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Admitted Prior Art in view of Petruzzi.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 32, mailed January 21, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 31, filed

December 17, 1998) and reply brief (Paper No. 33, filed March 25, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of

the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Claim 1, the sole independent claim on appeal reads as follows:

A grasping forceps for an endoscope comprising:
a flexible insertion section;
an operating wire passing through said insertion section and adapted to be advanced and retreated in accordance with an operation of an operating section connected to a hand side end of the operating wire; and
an elastic grasping section arranged in the leading end portion of said operating wire and composed of at least four elastic grasping members different in length having a habit of flexing such that leading end grasping portions formed at the leading ends of said elastic grasping members spread outward from a center axis of said insertion section;
wherein said leading end grasping portions formed at the leading ends of said at least four elastic grasping members different in length are spread in a spiral arrangement at the time of spreading of said elastic grasping section so that said leading end grasping portions are arranged at different distances from the center axis of the insertion section, the distances of said leading end grasping portions from the center axis of the insertion section increasing substantially monotonically.

In the sole rejection before us in this appeal, the examiner determined (answer, pp. 3-4) that the leading end grasping portions 11a, 12a and 13a of the Admitted Prior Art are spread in a spiral arrangement and are arranged at different distances from

the center axis of the insertion section. We do not agree for the reasons set forth by the appellants in their brief (pp. 5-8) and reply brief (pp. 1-2). In that regard, while the Admitted Prior Art does clearly teach an elastic grasping section arranged in the leading end portion of an operating wire and composed of three elastic grasping members different in length having a habit of flexing such that leading end grasping portions formed at the leading ends of said elastic grasping members spread outward from a center axis of said insertion section, the Admitted Prior Art clearly does not disclose that the leading end grasping portions of the three elastic grasping members are spread in a spiral arrangement at the time of spreading of the elastic grasping section so that the leading end grasping portions are arranged at different distances from the center axis of the insertion section, the distances of the leading end grasping portions from the center axis of the insertion section increasing substantially monotonically. The examiner's reliance on the Figures 1A, 1B and 2 as inherently disclosing that the leading end grasping portions are spread in a spiral arrangement and are arranged at different distances from the center axis of the insertion section is, in our view, sheer speculation, especially since patent application drawings are not drawn to scale. It is well-settled that under

principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). As the court stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. [Citations omitted.] If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Accordingly, it is our view that the combined teachings of the applied prior art would not have rendered the subject matter of claim 1 obvious at the time the invention was made to a person having ordinary skill in the art.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 3/1, 4/1, 10/1, 11/1, 12/1 and 22 dependent thereon, under 35 U.S.C. § 103 is reversed.

New grounds of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.

1. Claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant

must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

In our view the following limitation of claim 1 lacks written description support in the original disclosure:

wherein said leading end grasping portions formed at the leading ends of said at least four elastic grasping members different in length are spread in a spiral arrangement at the time of spreading of said elastic grasping section so that said leading end grasping portions are arranged at different distances from the center axis of the insertion section, the distances of said leading end grasping portions from the center axis of the insertion section increasing substantially monotonically.

Specifically, the recitation that "said leading end grasping portions are arranged at different distances from the center axis of the insertion section" and the recitation that "the distances of said leading end grasping portions from the center axis of the

insertion section increasing substantially monotonically" lack written description support in the original disclosure.

The original disclosure provides in numerous places that the leading end portions of the elastic grasping members are spread in a spiral arrangement/manner (see e.g., p. 7, p. 13 and Figure 5). In addition, the original disclosure provides (p. 14) that "the leading end portions of the respective elastic grasping members are arranged in the spiral manner as shown in Fig. 5 and spread outwards from the center axis of the insertion section 46 so as to be arranged along the circle of a diameter at least [ϕ] 20 mm in the spread state."

We have reviewed the originally filed disclosure and find no express disclosure for the above-noted limitations of claim 1. In addition to an express disclosure, the written description requirement can be satisfied by showing that the disclosed subject matter, when given its "necessary and only reasonable construction," inherently (i.e., necessarily) satisfies the limitation in question. See Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988). In our view, based upon the

original disclosure, one skilled in the art would understand² the term "spiral" as used in the original disclosure to mean "a three-dimensional curve that turns around an axis at a constant or continuously varying distance while moving parallel to the axis; a helix."³ Thus, it is our view that there is no inherent disclosure in the application to suggest the above-noted limitations from claim 1. In that regard, we note that a disclosure that merely renders the later-claimed invention obvious is not sufficient to meet the written description requirement; the disclosure must describe the claimed invention with all its limitations. See Tronzo v. Biomet Inc., 156 F.3d 1154, 1158-60, 47 USPQ2d 1829, 1832-34 (Fed. Cir. 1998); Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); Vas-Cath Inc., 935 F.2d at 1563-64, 19 USPQ2d at 1117; In re Winkhaus, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975); In re DiLeone, 436 F.2d 1404, 1405, 168

² In proceedings before it, the United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

³ The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company.

USPQ 592, 593 (CCPA 1971); In re Wohnsiedler, 315 F.2d 934, 937, 137 USPQ 336, 339 (CCPA 1963).

Similarly, it is our view the following limitation of claim 22 also lacks written description support in the original disclosure:

wherein with the exception of the leading end grasping portion closest to the center axis of the insertion section and the leading end grasping portion farthest from the center axis of the insertion section, each leading end grasping portion is positioned a distance away from the center axis of the insertion section which is between distances of adjacent leading end grasping portions from the center axis of the insertion section.

2. Claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

Our review of independent claim 1 reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, the terminology "increasing substantially monotonically" in independent claim 1 raises a definiteness issue under 35 U.S.C. § 112, second paragraph.

The term "substantially" is a term of degree. When a word of degree is used, such as the term "substantially" in claim 1, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

Admittedly, the fact that some claim language, such as the term of degree mentioned supra, may not be precise, does not automatically render the claim indefinite under the second paragraph of § 112. Seattle Box, supra. Nevertheless, the need to cover what might constitute insignificant variations of an invention does not amount to a license to resort to the unbridled use of such terms without appropriate constraints to guard

against the potential use of such terms as the proverbial nose of wax.⁴

In Seattle Box, the court set forth the following requirements for terms of degree:

When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), the court added:

If the claims, read in light of the specifications [sic], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.

⁴ See White v. Dunbar, 119 U.S. 47, 51-52 (1886) and Townsend Engineering Co. v. HiTec Co. Ltd., 829 F.2d 1086, 1089-91, 4 USPQ2d 1136, 1139-40 (Fed. Cir. 1987).

Indeed, the fundamental purpose of a patent claim is to define the scope of protection⁵ and hence what the claim precludes others from doing. All things considered, because a patentee has the right to exclude others from making, using and selling the invention covered by a United States letters patent, the public must be apprised of what the patent covers, so that those who approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, we have reviewed the appellants' disclosure to help us determine the meaning of the above-noted terminology from claim 1 and as noted previously have found no support therefore. Thus, the disclosure does not provide explicit guidelines defining the term "substantially" as used in the terminology "increasing substantially monotonically" (claim 1). Furthermore, it is our view that there are no guidelines that would be implicit to one skilled in the art defining the

⁵ See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

term "substantially" as used in the terminology "increasing substantially monotonically" that would enable one skilled in the art to ascertain what is meant by "substantially." Absent such guidelines, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. See In re Hammack, supra.

Since the appellants' disclosure fails to set forth an adequate definition as to what is meant by the terminology "increasing substantially monotonically" in claim 1 for the reasons set forth above, the appellants have failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22 under 35 U.S.C. § 103 is reversed and new rejections of claims 1, 3/1, 4/1, 10/1, 11/1, 12/1 and 22 under 35 U.S.C. § 112, first and second paragraphs, have been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED; 37 CFR § 1.196(b)

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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